



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/800, 742 02/14/97 FIELD

P 1233-272A

EXAMINER

35M1/0822

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BOUCHER, D. AR UNIT PAPER NUMBER

3508

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DATE MAILED:  
08/22/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on \_\_\_\_\_
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1 - 26 is/are pending in the application.  
Of the above, claim(s) 20 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1 - 19, 21 - 26 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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## DETAILED ACTION

### *Election/Restriction*

1. This application contains claims directed to the following patentably distinct species of the claimed invention: species A of figures 1-18 and species B of figure 19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 13 and 21 appear generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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2. During a telephone conversation with Vincent DeLuca on or about August 13, 1997 a provisional election was made with traverse to prosecute the invention of species A, claims 1-19 and 21-26. Affirmation of this election must be made by applicant in responding to this Office action. Claim 20 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

*Specification*

4. The use of the trademark "NITINOL" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

*Claim Rejections - 35 USC § 112*

5. Claims 2, 3, 5, 6, 7, 8, 11, 12, 14, 15, 16, 23, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 2, 3, 14, 15, 23

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and 24, it is not completely clear what element the "for" clauses at the end of these claims are further defining. It is suggested to add --, said recess-- prior to these "for" clauses to make it perfectly clear that "said recess" is "for receiving said extension . . ." or "for receiving said slider bar . . .". Applicant is reminded that if these "for" clauses are to be given patentable weight, the functional recitation must be positively recited or expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13, 17-19, 21, 22, 25 and 26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Aston 5,351,042. See particularly figure 4 and column 3, line 50 to column 4, line

8. Claims 1 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Thordmark et al. 5,542,274. With regards to claim 1, Thordmark et al. teaches all the elements of the claimed invention including a lock cylinder (figures 1-3) having side bar 7, blocking mechanism 10,11, electrically activated drive mechanism 12, and control means 4c. With regards to claim 21,

Thordmark et al. teaches all the elements of the claimed invention including barrel 3, outer shell 2, blocking mechanism 11, and electronic control means 12.

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 4, 5, 6, 9, 10, 11, 15, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aston 5,351,042 in view of Thordmark et al. 5,542,274. Aston teaches all the elements of the claimed invention with the exception of the nitinol wire actuator cooperating specifically on the sidebar of the locking mechanism to prevent rotation of the cylinder plug. Aston teaches slider bar 42, rocker (return pivot) and pusher (return spring) wherein a projection on the slider bar locks into a recess in the plug to prevent rotation. Thordmark teaches it is well known to use an electronic control means having a slider bar 11 in conjunction with a side-bar mechanism 10 wherein in the unlocked position a projection on the slider bar is accepted into a recess in the sidebar to allow rotation of the cylinder lock. Thordmark also teaches use of a convention sidebar 7 which is removable received in a cavity of the lock shell during rotation of the plug to the unlocked position. It would have been an obvious relocation of parts to one of ordinary skill in the art to attach the nitinol wire actuator to an electromechanical lock having a sidebar with a recess in a manner similar to that taught by Thordmark et al. since both configurations equally secure the cylinder lock in the lock position. Alternatively, with regards to claims 22-25, it would obvious to one of ordinary skill in the art to replace the complex solenoid

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actuator of Thordmark et al. with a simple nitinol wire actuator like that taught by Aston since the wire actuator is an effective known mechanism for controlling the locking function of an electromechanical lock.

11. Claims 3, 7, 8, 12, 14, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aston 5,351,042 in view of Thordmark et al. 5,542,274 and in further view of Surko, Jr. 4,638,651. It would have been an obvious rearrangement of location of parts to have the extension be on the sidebar and the recess to be part of the slider bar as taught by figures 9 and 10 of Surko, Jr. since both configurations allow for the sidebar to be locked by the slider bar in a first locking position and in the second unlocking position the slider bar is received with the side bar to allow retraction of the sidebar and rotation of the lock plug to the unlocked position.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darnell Boucher whose telephone number is (703) 308-2492.

dmb

August 17, 1997

*Darnell M. Boucher*  
DARNELL M. BOUCHER  
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GROUP 3500